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The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 32

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
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Ex parte EIICHI YOSHIDA

Appeal No. 2003-1867
Application No. 09/151,321

ON BRIEF

Before LEVY, BLANKENSHIP, and SAADAT, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-16 and 18-20.

We reverse.

BACKGROUND

The invention is directed to a system for selecting a network-connected image forming apparatus (e.g., a printer), in which a present job is registered in the apparatus, based on the apparatus already storing another job having the specific mode (e.g., a mode requiring a particular paper supply) with respect to the present job. Claim 1 is reproduced below.

1. A device for selecting a network-connected image forming apparatus from a plurality of network-connected image forming apparatuses, where each of at least two of the plurality of image forming apparatuses has a specific mode, the device comprising:

a controller for selecting one of the plurality of image forming apparatuses connected with the network,

wherein when an input job has a specific mode, said controller selects an image forming apparatus which has a specific mode and which stores a prior job having the specific mode of the input job at the time the selection is made, and

said controller for registering the input job in the selected image forming apparatus.

The examiner relies on the following evidence:

Hower, Jr. et al. (Hower)	5,467,434	Nov. 14, 1995
Maniwa et al. (Maniwa)	5,768,483	Jun. 16, 1998 (filed Sep. 24, 1996)
Shibusawa et al. (Shibusawa)	6,088,120	Jul. 11, 2000 (filed Mar. 26, 1997)

Appellant's admitted prior art (the APA).

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Claims 11-16, 19, and 20 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 1 and 6-10 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hower, Shibusawa, and Maniwa.

Claims 2-5 and 18 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hower, Shibusawa, and the APA.

Claims 11, 15, 16, 19, and 20 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hower and Maniwa.

Claims 12-14 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hower, Maniwa, and the APA.

Claim 17 has been canceled.

We refer to the Final Rejection (Paper No. 18) and the Examiner's Answer (Paper No. 28) for a statement of the examiner's position and to the Brief (Paper No. 27) and the Reply Brief (Paper No. 29) for appellant's position with respect to the claims which stand rejected.

OPINION

As the basis of the Section 112 rejection of claims 11-16, 19, and 20, the examiner objects to “new” limitations contained in present claims 11 and 16. The limitations are interpreted as reciting a server that “selects an image forming apparatus based on jobs stored in a memory of the image forming apparatus having the specific mode of the input job.” However, according to the examiner, page 18 of the specification relates that “a server 6 just select[s] a printer based on stored jobs in hard disk 206 of the server, not a memory of the printer, and printer status.”¹ (Answer at 3.)

We briefly review the requirements of the statute with respect to providing an enabling disclosure.

The first paragraph of 35 U.S.C. § 112 requires, inter alia, that the specification of a patent enable any person skilled in the art to which it pertains to make and use the claimed invention. Although the statute does not say so, enablement requires that the specification teach those in the art to make and use the invention without ‘undue experimentation.’ In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). That some experimentation may be required is not fatal; the issue is whether the amount of experimentation required is ‘undue.’ Id. at 736-37, 8 USPQ2d at 1404.

In re Vaeck, 947 F.2d 488, 495, 20 USPQ2d 1438, 1444 (Fed. Cir. 1991).

The question is whether the disclosure is sufficient to enable those skilled in the art to practice the claimed invention; the specification need not disclose what is well

¹ It is not apparent to appellant, nor to us, why the examiner did not include claim 1 and its depending claims in the rejection. Claim 1 recites that the controller selects an image forming apparatus based, in part, on its storing a prior job having the specific mode of the input job at the time the selection is made.

known in the art. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984) (citing In re Myers, 410 F.2d 420, 161 USPQ 668 (CCPA 1969)). "A patent need not teach, and preferably omits, what is well known in the art." Spectra-Physics, Inc. v. Coherent, Inc., 827 F.2d 1524, 1534, 3 USPQ2d 1737, 1743 (Fed. Cir. 1987). "Not every last detail is to be described, else patent specifications would turn into production specifications, which they were never intended to be." In re Gay, 309 F.2d 769, 774, 135 USPQ 311, 316 (CCPA 1962).

The examiner bears the initial burden of setting forth a reasonable explanation as to why the scope of protection provided by the claims is thought to be not adequately enabled by the description of the invention provided in the specification. If that burden is met, the burden then shifts to the applicant to provide proof that the specification is indeed enabling. In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

"Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The factors to be considered in determining whether a disclosure would require undue experimentation include:

- (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative

skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

Wands, 858 F.2d at 737, 8 USPQ2d at 1404.

The alleged absence of specific embodiments illustrating the invention is thus but one of the factors to be considered in whether undue experimentation may be required. The rejection asserts that server 6 selects a printer based on stored jobs in hard disk 206 of the server. The examiner has provided no reasoning or evidence as to why one skilled in the art would be unable to implement a system, absent undue experimentation, such that a controller on a network selects a printer based on jobs stored in a memory of the printer. We conclude that the rejection fails to set forth a prima facie case for lack of enablement of the claimed subject matter. ✓

Indeed, the examiner's findings in support of the rejection seem to be based more on an asserted lack of written description of the invention now claimed, rather than lack of enablement. To comply with the "written description" requirement of 35 U.S.C. § 112, first paragraph, an applicant must convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession of the invention. The invention is, for purposes of the "written description" inquiry, whatever is now claimed. Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991). However, the invention claimed does not have to be described in ipso verbis in order to satisfy the description requirement of 35 U.S.C. § 112, first

paragraph. Union Oil Co. v. Atlantic Richfield Co., 208 F.3d 989, 1000, 54 USPQ2d 1227, 1235 (Fed. Cir. 2000).

In any event, we see no basis for contending that the relevant feature lacks description in the original disclosure. As the examiner notes, page 18 of the specification states that job data is recorded on hard disk 206. Job registration server 6 ascertains printer status and information regarding jobs registered in printers connected to the network. Job registration server 6 also handles processing to select an appropriate printer "based on stored jobs and printer status." In isolation, the statement could be interpreted as relating that a printer is selected based on jobs stored on hard disk 206. However, the paragraph bridging pages 18 and 19 of the specification states that printers return "attributes for all stored jobs" (Fig. 7) to job registration server 6. The paragraph bridging pages 19 and 20 describes job registration server 6 as acquiring information from individual printers, and searching received printer data for a particular print mode. In contrast, the specification describes (pages 22 through 23) an alternative embodiment in which job registration server 6 maintains information such that job attribute information (e.g., requiring stop mode) need not be retrieved from printers over the network.

Thus, whether the Section 112 rejection is based on the requirements of enablement or the requirements of written description, we do not sustain the rejection.

Nor do we sustain any of the various rejections under 35 U.S.C. § 103. The rejections rely on the finding that Hower teaches the feature we have discussed in

relation to the Section 112 rejection. Hower is deemed to teach that the controller (server 25, Fig. 2) selects an image forming apparatus which has a specific mode in a prior job at the time the selection is made. "The printer properties are stored in the profiles before in the server. Thus, [t]he printer properties would be considered as the prior job which have a specific mode of the printer." (Answer at 13.)

Hower discloses, in column 4, that combination examiner 37 stores at least one copy of a printer profile 44 that is maintained by server 25, and matches print job selections with a combination of printer properties provided in the stored printer profile. Printer profiles 44 are expressly described at column 5, lines 10 through 21 of the reference. The printer profiles are composed of a set of descriptions of printing media available at the associated printer, a set of rules which describe the allowed ranges and interactions between media description parameters for the associated printer, and a set of rules which describe the finishing, formatting, and output capabilities of the associated printer. The printer profiles thus do not contain information with respect to the jobs stored in memory such that a comparison may be made with the specific mode of the input job. As such, we find no disclosure or suggestion for (claim 1) a controller that selects an image forming apparatus based, in part, on the circumstance that the apparatus stores a prior job having the specific mode of the input job at the time the selection is made.

Independent claims 11 and 16 contain substantially the same requirements that we find lacking in the rejection of claim 1. The relied-upon evidence does not show

disclosure or suggestion for all the requirements of at least the respective independent claims.

The rejections of the claims under 35 U.S.C. §§ 112 and 103 are reversed.

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